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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,768	02/07/2002	Edmund Ming Kwan	PA2354US	1636
32566	7590	06/23/2006	EXAMINER	
PATENT LAW GROUP LLP 2635 NORTH FIRST STREET SUITE 223 SAN JOSE, CA 95134			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,768

Applicant(s)

KWAN, EDMUND MING

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 40-42, 44-46, 48-51, 56, 57 and 98-111 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-42, 44-46, 48-51, 56, 57 and 98-111 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

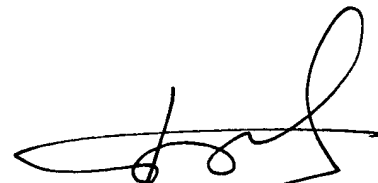
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



IGOR N. BORISSOV  
PRIMARY EXAMINER

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 11/17/2005 is acknowledged and entered. Claims 1-39, 43, 47, 52-55 and 58-97 have been canceled. Claims 40-42, 44-46, 48-51, 56 and 57 have been amended. New claims 98-111 have been added. Claims 40-42, 44-46, 48-51, 56, 57 and 98-111 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-42, 44-46, 48-51, 56, 57 and 98-111 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 98 recites the limitation "the partners" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 98 recites intermittently the following terminology: "collaboration partners", "partners", "subscribing partner", "non-subscribing partner", which is confusing. It is not clear the relationship of said *partners*, and how their functionalities differ from each other. Same reasoning is applied to claims 50, 56, 57 and 107.

Claim 98 further recites: "determining a value based on applying a predetermined function to a subscription fee paid by one or more subscribing partners; wherein the value indicates a net saving to the host subscription fee for the client for using the hosted enterprise solution", which is confusing. So as the limitations recited in "wherein" clause are not positively claimed, it is not clear whether they are part of the invention. MPEP 2106 (C) states: "Language that suggests or makes optional *but does not require steps to be performed* or does not limit a claim to a particular structure does not limit the

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scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.”

Same reasoning is applied to claim 106.

Claim 98 further recites: “monitoring each non-subscribing partner ... who does not enroll a subscription ... and does not contribute to the value; and updating the client’s host subscription fee based at least in part on the value”.

It is not clear how the step of “monitoring of each non-subscribing partner” relates to the method recited. Said “monitoring” step does not depend on the previous sub-steps of the claim, and does not affect the last sub-step of “updating the client’s host subscription fee”.

Furthermore, claims 40, 41, 44, 45, 56, 57, 99 and 111 comprise the term “enabling”, which is confusing. It is not clear what an actual method step is considered in those claims.

Claim 42 recites: “wherein each subscribing partner is one of two or more types of subscribing partners with different user’s privileges”, which is confusing. It is not clear how the term “privileges” differs from the term “right of usage” in claims 56 and 107.

Claim 51 comprises the term “facilitates”, which is confusing. It is not clear what does this term actually contemplate.

Claim 99 recites: “enabling the client to decide which partners in the collaboration community are not invited to become subscribing partners”, which is confusing. Claim 98, which is parent to claim 99, recites “subscribing partners” and “non-subscribing partners”, which means that the “decision” already made. Same reasoning is applied to claims 40, 41, 44, 103, 104 and 111. Furthermore, as per claims 45 and 111, it is not clear what the following terms actually mean: “standard” and “open policy”. At this point it is noted that although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claims 101, 103, 106 and 107 comprise the term “allowing”, which is confusing. It is not clear what an actual method step is considered in those claims.

Claim 101 recites: “allowing the client to invite partners to pay subscription fees”, which is confusing. Claim 98, which is parent to claim 101, recites “subscribing partners” and “non-subscribing partners”.

Claim 102 recites the step of: “tracking partners that decline subscriptions”, which is confusing. Claim 98, which is parent to claim 102, does not provide any indication regarding “declining subscription partners”, and recites only “subscribing partners” and “non-subscribing partners”. However, “declining subscription partners” and “non-subscribing partners” are not the same.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 40-42, 44-46, 48-51, 56, 57 and 98-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (US 2005/0055306) in view of Shorter (US 2002/0198782).**

Claim 98. Miller et al. (hereinafter Miller) teaches a method for creating a user-defined collaborative environment, comprising:

generating a list of the partners that forms at least a portion of the collaboration community [0272]; [0275];

charging a client (a person or entity creating the community) a service fee based on the number of members in the collaboration community by applying a predetermined function [0269];

monitoring each subscribing partner in the portion of the collaboration community who enrolls a subscription for his use of the hosted enterprise solution as part of being in the collaboration community and thereby contributes to the value (function) [0272]; [0289]; [0303];

monitoring each non-subscribing partner in the portion of the collaboration community who does not enroll a subscription for his use of the hosted enterprise solution as part of being in the collaboration community and thereby does not contribute to the value [0272]; [0274]; [0303];

updating the client's host subscription fee based at least in part on the value [0269].

While Miller teaches that a function is applied to charge a client a service fee based on the number of members in the collaboration community [0269], Miller does not specifically teach that said function is applied to a subscription fee paid by each subscribing partners to determine a value which indicates a net saving for the client for his host subscription fee for using the hosted enterprise solution.

Shorter teaches a method for retaining customers of a network solution by applying an incentive on a monthly, on-going basis, comprising:

generating by a client (user) a list of referred partners (subscribers) [0054]; generating a value by applying a predetermined function to a referred subscribers subscription fee [0035] - [0038]; [0045]; modifying client's host subscription fee based upon results of said generated value [0035] - [0038]; updating relevant information regarding subscription fee [0041]; [0047]; [0051]; and utilizing a network for communicating a balance of said client's host subscription fee to the user [0030]; [0047].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Miller to include that said function is applied to a subscription fee paid by each subscribing partners to determine a value which indicates

a net saving for the client for his host subscription fee for using the hosted enterprise solution, as disclosed in Shorter, because it would advantageously allow to provide the low cost use of partner-funded incentives (over time) in a loyalty model that delivers both customer retention (loyalty), and uses leverages for multiple new acquisitions, as specifically stated in Shorter [0012].

Claims 40, 41, 44-46, 99, 101, 103 and 104. Miller teaches: deciding by the client which partners in the collaboration community to invite to become subscribing partners [0272]-[0275]; [0290].

Claims 42, 56, 57, 106 and 107. Miller teaches: the client creates a password for each user (partner) [0289], thereby indicating assigning privileges to the partners.

Claim 48. Shorter teaches that the subscription fee and the value are different amounts [0035] - [0038]; [0041].

Claim 49. Miller teaches accounting for the status of the subscribing partners [0303].

Claims 50, 51 and 108-110. See reasoning applied to claim 98.

Claim 100. Miller teaches charging the client a service fee [0269], thereby indicating communicating the balance of the host subscription fee to the client. Furthermore, it is old and well known to charge customers over a network.

Claim 102. Miller teaches: tracking partners that decline subscriptions [0303]; [0290].

Claim 105. Shorter teaches tracking the host subscription fee (updating relevant information regarding subscription fee) [0041]; [0047]; [0051].

Claim 111. Miller teaches: deciding by the client which partners in the collaboration community to invite to become subscribing partners [0272]-[0275]; [0290].

### ***Response to Arguments***

Applicant's arguments with respect to claims 40-42, 44-46, 48-51, 56, 57 and 98-111 have been considered but are moot in view of the new ground(s) of rejection.

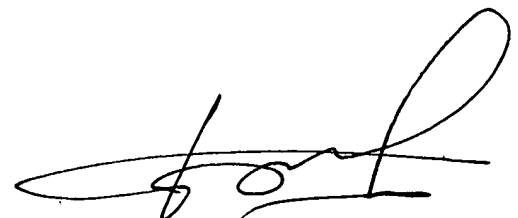
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
6/12/2005

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a large, stylized loop at the end.

IGOR N. BORISSOV  
PRIMARY EXAMINER